

REMARKS / DISCUSSION OF ISSUES

Claims 1-19 and 36-40 are pending in the present application. Claims 1-19 have been amended. Claims 36-40 have been presented herewith.

Rejections Under 35 U.S.C. § 112

Claims 1-19 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Although Applicant does not necessarily agree with this rejection, the claims have been amended responsive to the concerns raised in an effort to be in better compliance with 35 U.S.C. § 112, second paragraph and to advance prosecution. The phrases "in particular", "particularly" and "characterized in that" have been deleted. Applicant respectfully submits that the claims are in compliance with 35 U.S.C. § 112, second paragraph, and urges the Examiner to withdraw this rejection.

Rejections Under 35 U.S.C. § 102

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by either of *Heldmann et al.* (Eur. Radiol.) or *Wasterby et al.* (Journal of Magnetic Resonance). This rejection, insofar as it may pertain to the presently pending claims, is traversed for the following reasons.

Applicant relies at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res.*

Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Applicant's silence on certain aspects of the rejection is by no means a concession as to their propriety. Rather, because the applied art fails to disclose at least one feature of the claims, for at least the reasons discussed below, Applicant respectfully submits that the rejections are improper and should be withdrawn.

The method of claim 1 includes in combination among other features "introducing coated magnetic particles having a coating into at least part of the examination area", "wherein the coating is degradable and inhibits mobility of the particles".

Applicant respectfully submits that neither *Heldmann et al.* nor *Wasterby et al.* disclose or suggest introducing coated magnetic particles into an examination area, wherein the coating is degradable and inhibits mobility of the particles. The relied upon prior art as taken in the alternative thus fail to meet all the features of claim 1. Applicant therefore respectfully submits that the method of claim 1 distinguishes over the relied upon prior art as taken alternatively, and that this rejection, insofar as it may pertain to claim 1, is improper for at least these reasons.

Claims 2-19

Although claims 2-19 have not been rejected based upon prior art, Applicant respectfully submits that claims 2-19 distinguish over the relied upon prior art at least by virtue of dependency on claim 1 for the reasons set forth above.

Claims 36-40

Applicant respectfully submits that claims 36-38, as ultimately dependent on claim 1, distinguish over the relied upon prior art at least by virtue of dependency on claim 1 for the reasons set forth above.

The method of claim 39 includes in combination among other features "introducing at least partially coated magnetic particles having a partial coating into at least part of the examination area", and "wherein the partial coating is degradable and inhibits mobility of the particles".

Applicant respectfully submits that neither *Heldmann et al.* nor *Wasterby et al.* disclose or suggest introducing at least partially coated magnetic particles into an examination area, wherein the partial coating is degradable and inhibits mobility of the particles. The relied upon prior art as taken in the alternative thus fail to meet all the features of claim 39. Applicant therefore respectfully submits that the method of claim 39 distinguishes over the relied upon prior art as taken alternatively for at least these reasons.

The method of claim 40 includes in combination among other features “introducing magnetic particles into at least part of the examination area and coating at least some of the particles in the examination area with a coating”, and “wherein the coating is degradable and inhibits mobility of the particles”.

Applicant respectfully submits that neither *Heldmann et al.* nor *Wasterby et al.* disclose or suggest introducing magnetic particles into an examination area and coating at least some of the magnetic particles in the examination area, wherein the coating is degradable and inhibits mobility of the particles. The relied upon prior art as taken in the alternative thus fail to meet all the features of claim 40. Applicant therefore respectfully submits that the method of claim 40 distinguishes over the relied upon prior art as taken alternatively for at least these reasons.

Conclusion

In view of the foregoing, Applicant respectfully requests that the Examiner withdraws the rejections of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.



by: Andrew J. Telesz, Jr. (Reg. No. 33,581)
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Volentine & Whitt, PLLC
One Freedom Square
11951 Freedom Drive, Suite 1260
Reston, Va., 20190
(571) 283-0720 (v)
(571) 283-0740 (f)